

**REMARKS**

**Claim Amendments**

The Examiner will note that the claims have been amended merely to correct minor typographical errors. Also, means-plus-function language has been eliminated.

**The Rejections of the Claims**

The Examiner rejected Claims 1-4 under 35 U.S.C. § 102(e) as anticipated by Ponce de Leon et al, and rejected Claims 5-8 under 35 U.S.C. § 103(a) as unpatentable over Ponce de Leon et al. in view of Caci. These rejections are respectfully traversed.

**The Ponce de Leon et al. Patent is Not Entitled to the Claimed Provisional Application Filing Date**

The Ponce de Leon et al. patent issued from an application filed May 23, 2000, claiming the domestic priority of provisional application Serial No. 60/185,923, filed February 29, 2000.

Under 35 U.S.C. § 111(b)(1), a provisional application “*shall* include —

(A) a specification as prescribed by the first paragraph of section 112 of this title; and

(B) a drawing as prescribed by section 113 of this title.”  
(Emphasis added.)

35 U.S.C. § 112, first paragraph, of course, requires that “the specification must contain a written description of the invention, and of the manner and process

of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art ... to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.”

35 U.S.C. § 119(e)(1) says that a non-provisional application is entitled to the benefit of the filing date of a provisional application which discloses the same invention “in a manner provided by the first paragraph of section 112 of this title”.

So, in short, if the Ponce de Leon et al. provisional application does not comply with 35 U.S.C. § 112, first paragraph, and/or does not contain a drawing, Ponce de Leon patent No. 6,211,791 is not entitled to the filing date thereof. It is necessary, therefore, to inspect the provisional application to see if it complies with the statutory requirements. A copy of Ponce de Leon et al. provisional application serial No. 60/185,923 is attached hereto as Exhibit A.

It will be seen that the application consists of one page and no drawings. The one page has four paragraphs telling what the device is supposed to do and where it will be used, and four paragraphs extolling its advantages. By no stretch of the imagination does this comply with the written description, enablement, and best mode requirements of Section 112, first paragraph.

Since the provisional application does not comply with Section 112, first paragraph, and does not have a drawing, the Ponce de Leon et al. patent is not entitled to the benefit of the provisional filing date. The patent, therefore, is a reference only as of its actual U.S. filing date of May 23, 2000.

**The Instant Application is Entitled to its Japanese Priority Date**

The instant application is entitled to its Japanese Priority Date of May 26, 2000. Even though a certified copy of the Japanese application No. 2000-156925 was filed with the International Bureau and a copy transmitted to the PTO, it was not acknowledged as having been received. In order to insure that it is considered by the Examiner, another certified copy is being filed concurrently herewith. A verified translation is being submitted as Exhibit B to this Reply.

It is noted that the instant application is then entitled to an effective filing date of May 26, 2000.

**The Instant Invention was Made Prior to May 23, 2000**

Applicants are submitting herewith as Exhibit C a Declaration of Mr. Hiroaki Tokairin under Rule 131.

Mr. Tokairin is a manager of the Intellectual Property Department of Hitachi Construction Machinery Co., Ltd., the assignee of the instant application. Mr. Tokairin declares that one of the inventors, Mr. Hiroshi Watanabe, submitted a disclosure of the invention to the Intellectual Property Department of Hitachi Construction Machinery Co., Ltd., prior to May 23, 2000, the actual filing date of the Ponce de Leon et al. application. A copy of that disclosure is attached to Mr. Tokairin's Declaration as Exhibit 1. Even though that disclosure has not been translated, a simple comparison of the drawings forming a part of that disclosure with the drawings of the Japanese priority application, the translation thereof, and

the drawings of the instant application will show that the inventors had possession of the invention prior to May 23, 2000.

Mr. Tokairin further declares that he prepared and completed the Japanese application based on the disclosure received from Mr. Watanabe.

**The Rejection over Ponce de Leon et al. Falls**

Based on Mr. Tokairin's Declaration and the accompanying exhibits it is clear that the instant invention was made prior to May 23, 2000, and the Ponce de Leon et al. patent, therefore, is no longer a reference.

Caci alone does not anticipate or render obvious the claimed invention. Accordingly the claims are all patentable.

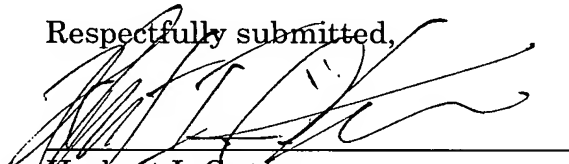
Since all the claims are clearly in condition for allowance and distinguish over the prior art of record, whether taken singly or in combination, an early Notice of Allowance is in order and the same is most earnestly solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #080306.50888).

February 18, 2005

Respectfully submitted,

  
Herbert I. Cantor  
Registration No. 24,392

CROWELL & MORING LLP  
Intellectual Property Group  
P.O. Box 14300  
Washington, DC 20044-4300  
Telephone No.: (202) 624-2500  
Facsimile No.: (202) 628-8844  
HIC:moi

<b>SERIAL NUMBER</b> 60/185,923	<b>FILING DATE</b> 02/29/2000 <b>RULE</b>	<b>CLASS</b> -	<b>GROUP ART UNIT</b> -	<b>ATTORNEY DOCKET NO.</b> -
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**APPLICANTS**  
 Sherry A. Ponce De Leon, Chicago, IL ;  
 Conrad Pagan, Chicago, IL ;

**\*\* CONTINUING DATA \*\*\*\*\***

**\*\* FOREIGN APPLICATIONS \*\*\*\*\***

**IF REQUIRED, FOREIGN FILING LICENSE GRANTED \*\* SMALL ENTITY \*\***  
 \*\* 04/26/2000

Foreign Priority claimed <input type="checkbox"/> yes <input type="checkbox"/> no 35 USC 119 (a-d) conditions met <input type="checkbox"/> yes <input type="checkbox"/> no <input type="checkbox"/> Met after Allowance Verified and Acknowledged _____ Examiner's Signature Initials	<b>STATE OR COUNTRY</b> IL	<b>SHEETS DRAWING</b> -	<b>TOTAL CLAIMS</b> -	<b>INDEPENDENT CLAIMS</b> -
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**ADDRESS**  
 Sherry Ponce De Leon RN PHNIII  
 333 S State  
 Chicago ,IL 60604

**TITLE**  
 Apparent temperature alarm (combined temperature/humidity alarm)

<b>FILING FEE RECEIVED</b> 200	FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following:	<input type="checkbox"/> All Fees <input type="checkbox"/> 1.16 Fees ( Filing ) <input type="checkbox"/> 1.17 Fees ( Processing Ext. of time ) <input type="checkbox"/> 1.18 Fees ( Issue ) <input type="checkbox"/> Other _____ <input type="checkbox"/> Credit
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PATENT APPLICATION SERIAL NO. \_\_\_\_\_

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE  
FEE RECORD SHEET

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33-214/80404

# PROVISIONAL APPLICATION FOR PATENT COVER SHEET

This is a request for filing a PROVISIONAL APPLICATION FOR PATENT under 37 CFR 1.53 (c).

INVENTOR(S)					
Given Name (first and middle [if any])		Family Name or Surname		Residence (City and either State or Foreign Country)	
Sherry A. Conrad		Ponce De Leon Pagan		333 S. State Chicago, IL 2150 N. California Chgo, IL	
<input type="checkbox"/> Additional inventors are being named on the _____ separately numbered sheets attached hereto					
TITLE OF THE INVENTION (280 characters max)					
Apparent Temperature Alarm (combined temperature/humidity alarm)					
CORRESPONDENCE ADDRESS					
Direct all correspondence to:					
<input type="checkbox"/> Customer Number		<input type="text"/>		Place Customer Number Bar Code Label here	
OR Type Customer Number here					
<input checked="" type="checkbox"/> Firm or Individual Name		Sherry Ponce De Leon, RN, PHNIII			
Address		333 S. State Chicago, IL 60604 or			
Address		Conrad Pagan 2150 N. California Chgo, IL 60647			
City		Chgo		IL State	ZIP 60647
Country		U.S.A.	Telephone	312 747-9709	Fax 312 7479716
ENCLOSED APPLICATION PARTS (check all that apply)					
<input checked="" type="checkbox"/> Specification Number of Pages		1		<input type="checkbox"/> Small Entity Statement	
<input type="checkbox"/> Drawing(s) Number of Sheets		<input type="text"/>		<input type="checkbox"/> Other (specify) <input type="text"/>	
METHOD OF PAYMENT OF FILING FEES FOR THIS PROVISIONAL APPLICATION FOR PATENT (check one)					
<input checked="" type="checkbox"/> A check or money order is enclosed to cover the filing fees				FILING FEE AMOUNT (\$)	
<input type="checkbox"/> The Commissioner is hereby authorized to charge filing fees or credit any overpayment to Deposit Account Number: <input type="text"/>				75.00	
The invention was made by an agency of the United States Government or under a contract with an agency of the United States Government.					
<input checked="" type="checkbox"/> No.					
<input type="checkbox"/> Yes, the name of the U.S. Government agency and the Government contract number are: _____					

Respectfully submitted, Sherry Ponce De Leon

Date 2, 22, 00

SIGNATURE Sherry Ponce De Leon

TYPED or PRINTED NAME Sherry Ponce De Leon

Conrad Pagan

TELEPHONE 312 747 9709

REGISTRATION NO.

(if appropriate)

Docket Number:

## USE ONLY FOR FILING A PROVISIONAL APPLICATION FOR PATENT

This collection of information is required by 37 CFR 1.51. The information is used by the public to file (and by the PTO to process) a provisional application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the complete provisional application to the PTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, D.C., 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Box Provisional Application, Assistant Commissioner for Patents, Washington, D.C., 20231.

Jc541 U.S. PTO  
60/185923



The PTO did not receive the following listed item(s) Small entity fee



1. The device will be used as a home monitoring instrument, to measure a predetermined apparent temperature index. (The apparent temperature index is the combination effect of high temperature/ relative humidity on humans.)
2. The device is designed to prevent morbidity and mortality for individuals at high risk for heat related illnesses, by alarming at a predetermined apparent temperature, alerting its occupants of existing danger.
3. The device can be connected to burglar alarms, or telephones, to contact local emergency response systems.
4. The internal mechanism of the device will contain weather monitoring instruments necessary for measurement of the apparent temperature index, such as temperature sensors, humidity sensors, and alarm. In addition it may contain the necessary components for connection to the emergency response systems.

#### STATEMENT OF ADVANTAGES

1. The device can be used in research for the purpose of the prevention of morbidity and mortality among high risk individuals during upcoming heat waves, caused by atmospheric changes due to "Global Warming."
2. The device can be used municipally in high risk cities (known as heat islands, due to abundance of concrete) who already have the "threshold" for morbidity and mortality caused by heat. The cities would be addressing a preventable cause of death for its indigent population at a low cost.
3. The device is a workable form of communication, that will link often difficult, non-compliant citizens, or citizens living alone, to a life saving source. Other forms of home monitoring systems have proven to be successful in the prevention of death (carbon monoxide detectors, and smoke alarms.)
4. The device is small, light weight, affordable, and economical to the general population.

#### READ AND UNDERSTAND

Chris Stewart  
Disinterested Witness

2/23/00  
Date

Viviana R. Bobba  
Disinterested Witness

2/23/00  
Date

#### COINVENTORS

Signature

Sherry Ponce De Leon  
Sherry Ponce De Leon

333 S. State Chicago, IL  
60604 312 747-9709

Signature

Conrad Pagan  
Conrad Pagan

2150 N. California Chicago, IL  
60647 312 747-8290